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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,888	07/29/2003	David W. Bartley	GRLK0078	5567

27268 7590 09/20/2005

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EXAMINER	
OH, TAYLOR V	

ART UNIT	PAPER NUMBER
1625	

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/629,888	Applicant(s) BARTLEY ET AL.	
	Examiner Taylor Victor Oh	Art Unit 1625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 August 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see pages 2-7.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

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It is noted that applicants have filed an Amendment after the Final Rejection on 8/8/05; applicants' attorney has addressed the issues of record. The proposed amendment will be entered ;however, it is not in a condition for allowance.

The Status of Claims

Claims 1-15, 17-32, and 34-35 are pending.

Claims 1-15, 17-32, and 34-35 have been rejected.

Claim Rejections-35 USC 112

1. Applicants' argument filed 4/11/05 have been fully considered but they are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 7 and 27 has been withdrawn due to the modification made in the amendment, whereas the rejection of Claims 1, 15, 19, , 32 ,and 34 has been maintained due to applicants' failure to modify the claims in the amendment.

Claim Rejections-35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of Claims 19-32 under 35 U.S.C. 102(b) as being anticipated clearly by Hill et al (U.S. 5,637, 757) has been rebutted, thereby the claim rejections ***19-32*** under 35 USC 102 (b) has been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The rejection of Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over Hill et al (U.S. 5,637, 757) in view of Finley (U.S. 4,375,551) has been maintained.

The rejection of Claims 1-35 under 35 U.S.C. 103(a) as being unpatentable over Hill et al (U.S. 5,637, 757) in view of Finley (U.S. 4,375,551) has been maintained with reason for the record on 1/12/05.

Applicants' attorney has addressed the issues of record; however, has not rebutted the claim rejections *1-35* under 35 USC 103 (a).

Applicants' Argument

2. Applicants argue the following issues:

a. Hill describes that a reaction mixture was brought to reflux from ambient conditions , unlike the claimed process in which at least one reactor having a temperature that favors decarboxylation over esterification;

b. Finley does not involve decarboxylation ; therefore, this prior art is unrelated to pre-heating the reaction mixture in the reactor to the favorable decarboxylation temperature ;

c. Finley does discloses recycle of the cooled solution from which the diester was separated , unlike the claimed process are directed to the use of reactors containing tetrabromo-benzoate ester at temperatures that favor decarboxylation over esterification.

The applicants' argument have been noted, but these arguments are not persuasive.

First, with respect to the first argument, the Examiner has noted applicants' argument. However, with respect to the pre-heated reactor, regardless of preheating the reaction mixture in the reactor, it is directed to the optimization of the reaction process, not the novelty of the process ; it is well-known in the secondary Finley art that it is desirable to heat the reaction

mixture to accelerate the reaction in comparison with no external application of heat (see col. 3, lines 27-30). Therefore, it would have been obvious to the skilled artisan in the art to be motivated to pre-heat the reaction mixture in the reactor to the favorable decarboxylation temperature as shown in the Hill process in order to optimize the reaction process because the skilled artisan in the art would expect such a modification to be successful and such an operation is well-known in the art to the skilled artisan in the art in the absence of an unexpected result.

Second, with respect to the second argument, the Examiner has noted applicants' argument. However, the secondary Finley has employed to supplement the primary Hill reference regarding the temperature at which the partial esterification takes place, whereas Hill et al does disclose a general teaching of the reaction temperature regarding both esterification of the anhydride and decarboxylation (see col. 1 ,lines 46-48) when the passages of Hill et al are reviewed; for example, the alcohols with the boiling points between 160^0 and 230^0 C may be advantageous (see col. 4, lines 26-28) in the reaction process. Therefore, applicants' argument is irrelevant to the issues of the currently claimed invention.

Third, with respect to the third argument, the Examiner has noted applicants' argument. However, whether or not the cooled solution is recycled in the secondary Finley, the fact still remains the same in that the secondary Finley does teach the recycling step for the process. Furthermore, the Hill process expressly discloses that it is quite possible that the reaction process can go into the formation of tetrabromobenzoate by decarboxylation as shown in Scheme I (col. 2 ,lines 13-38), whereas , in addition to the use of plural reactors, the Finley does teach

the temperature at which the partial esterification (a half-ester intermediate) takes place. Therefore, it would have been obvious to the skilled artisan in the art to be motivated to incorporate the limitations of the Finley's optimum first-step reaction temperature together with the recycling step into the Hill et al process in order to economize the reaction process as well as to react all the reactants to its completion. This is because the skilled artisan in the art would expect such an incorporation of the Finley's optimum first-step reaction temperature parameter and the recycling step into the Hill et al process to be successful and to be efficient as the guidance shown in the Finley.

Therefore, applicants' argument is irrelevant to the issues of the currently claimed invention.

Therefore, the rejection of the claim has been maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*** 9/16/05

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